

Docket No.: RSW919990104US1 (7161-150U)

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

Jason Y. Blakely, et al.

Application No.: 09/577,722

Filed: May 23, 2000

For: METHOD AND SYSTEM FOR DYNAMIC CREATION OF MIXED LANGUAGE
HTML CONTENT THROUGH MT

: Customer Number: 46320
:
: Confirmation Number: 3618
:
: Group Art Unit: 2178
:
: Examiner: D. Nguyen
:

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

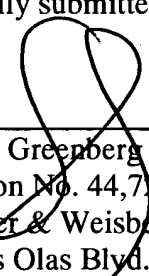
Sir:

Submitted herewith is Appellants' Appeal Brief in support of the Notice of Appeal filed March 22, 2005. Please charge the Appeal Brief fee of \$500.00 to Deposit Account 09-0461.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

May 20, 2005

Respectfully submitted,



Steven M. Greenberg
Registration No. 44,725
Christopher & Weisberg, P.A.
200 E. Las Olas Blvd., Suite 2040
Fort Lauderdale, FL 33301
Tel: (954) 828-1488
Facsimile: (954) 828-9122



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APPEAL BRIEF

Mail Stop Appeal Brief - Patents
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Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed March 22, 2005,
wherein Appellants appeal from the Examiner's rejection of claims 1-12.

I. REAL PARTY IN INTEREST

This application is assigned to International Business Machines Corporation by
assignment recorded on May 23, 2000, at Reel 010845, Frame 0744.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

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III. STATUS OF CLAIMS

Claims 1-12 are pending and finally rejected in this Application. It is from the final rejection of claims 1-12 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

A Request for Reconsideration was submitted on January 24, 2005. According to the Advisory Action dated March 7, 2005, the Request for Reconsideration has been considered; however, the Examiner maintained the rejection of claims 1-12.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claims 1, 4, and 7 are respectively directed to a method, system, and program product for dynamically creating mixed language HTML content in text through the use of machine translation. As recited in the claims, an HTML "lang" attribute is used to designate a target language to which a demarcated portion of the text is to be translated. By utilizing the "lang" attribute, multiple machine translation decisions can be performed within a single markup language page to create a mixed language document (paragraph spanning pages 5 and 6 of the specification). Specifically, while portions of the document are translated into one language, other portions of the same document can be translated into another language. By creating a facility for performing the mixed language translation of content within one document, single documents can be translated into mixed language output automatically and "on the fly" so as to support the translation of different parts of an HTML page from any language into any other.

VI. ISSUES TO BE REVIEWED ON APPEAL

1. Claims 1, 3-4, 6-7, and 9 were rejected under 35 U.S.C. § 102 for anticipation based

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upon Lakritz, U.S. Patent No. 6,623,529;

2. Claims 2, 5, and 8 were rejected under 35 U.S.C. § 103 for obviousness based upon Lakritz in view of Grefenstette, U.S. Patent No. 6,396,951; and

3. Claims 10-12 were rejected under 35 U.S.C. § 103 for obviousness based upon Lakritz.

VII. THE ARGUMENT

THE REJECTION OF CLAIMS 1, 3-4, 6-7, AND 9 UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON LAKRITZ

For convenience of the Honorable Board in addressing the rejections, claims 2-9 stand or fall together with independent claim 1.

Prosecution History

In the second Office Action dated May 7, 2004 , the Examiner rejected claims 1-9 under 35 U.S.C. § 102 for anticipation based upon Lakritz. In an Amendment filed August 9, 2004, Appellants responded to this rejection on page 8 by arguing:

Importantly, Lakritz provides for the translation of the entirety of a document into a single target language. In the Applicant's invention, however, a document can be translated into mixed languages within a single document. Specifically, portions of the document can be translated into one language, while other portions of the same document can be translated into another language. So much can be accomplished through the inventive use of the HTML 'lang' attribute which can be applied to demarcate portions of the document for translation into a specific language. This capability is not evident within the teachings of the Lakritz specification, and particularly within Figure 12 and its accompanying text. (Emphasis in original)

In the Final Office Action dated October 24, 2004 (hereinafter the Final Office Action), the Examiner maintained the same rejection of independent claims 1, 4, and 7. In the statement of the rejection on page 3 of the Final Office, the Examiner asserted:

automatically programmatically translating the portion having the first language into said at least

one target language with said 'lang' attribute as a key for machine translation in order to produce a mixed translation of the text (col 6, lines 3-34: "This allows ..., such that only a portion of the document on the site need be translated ... this also gives the customer the option of translating only a subset of the total content on the site ..."; the fact that only a portion of the documents on the site need to be translated shows that the translated portion has a target language which is different from the language used for the entire web documents, the web documents are produced as a mixed translation of the text; **figure 5, #505**; the Language-specific elements implies that the specific element in a document is translated into a target language which is different from the language of the entire documents) (Emphasis in original)

In the *Response to Arguments* portion on page 7 of the Final Office Action, the Examiner also asserted:

Lakritz, besides disclosing the translation of the entire document into a single target language as mentioned in the previous office action, also discloses a mixed translation of an HTML document where a portion of text in a language is translated to another language as mentioned in the claim rejection above.

In a Request for Reconsideration filed January 24, 2005, Appellants' response, in part, to these assertions by the Examiner is as follows:

In response, the Applicants respectfully traverse the rejections on the art which can be summarized as follows. Lakritz teaches only the translation of HTML content into a single target language as defined by "the current language" selected based upon the preferred language for a Web site visitor. No where in Lakritz is it ever suggested that a single document can include two or more different languages within the single document ...

Turning now to the rejections on the art, Lakritz relates to a multilingual electronic document translation, management, and delivery system. In the preferred embodiment of the Lakritz invention, the language (that is to say, only one language) and country of a Web site visitor can be automatically determined. Consequently, the Web server hosting the content can be directed to serve the content in a language (again, only one language) corresponding to that of the Web site visitor. In this way, language independent content can be developed and deployed to Web site visitors flexibly without requiring different Web site versions for different visitors from different countries. (Emphasis in original)

In an Advisory Action dated March 7, 2005, the Examiner responded to Appellants arguments by (twice) quoting column 6, lines 3-34 of Lakritz. Both quotes by the Examiner read as follows: "This allows ... such that only a portion of the document on the site need be translated ... this also gives the customer the option of translating only a subset of the total content on the site ..." The Examiner then concluded:

Clearly, the fact that "only a portion of the document on the site need to be translated" or "translating only a subset of the total content on the site" show a mixed translation of the

document since there are two languages included in the document, one language for the translated portion, and one language for the remaining content of the document. In other words, there are different languages included within a single document.

Examiner has misquoted Lakritz

As very evident from the Final Office Action and the Advisory Action, the Examiner has placed great emphasis on the disclosure found in column 6, lines 3-34 of Lakritz. Specifically with regard to the phrase "only a portion of the document on the site need be translated," the Examiner placed this phrase in italics and underline in the Final Office Action and quoted this phrase three times in the Advisory Action. The following is a correct quote from column 6, lines 21-25 of Lakritz:

This allows a multilingual Web site to be built incrementally, such that only a portion of the documents on the site need be translated and documents not available in a requested language will be served in the next most appropriate language for a Web site visitor.

Thus, the phrase repeatedly cited by the Examiner actually reads "only a portion of the documents on the site need be translated" (emphasis added). This misquotation of Lakritz has lead the Examiner to mistakenly believe that "there are different languages included within a single document." Instead, by referring to documents, Lakritz only explicitly discloses the portions (i.e., single documents) need be translated, which is consistent with Appellants' prior argument that Lakritz is directed to a system that translates the entirety of a document into a single target language.

Another of the quotes from Lakritz (i.e., "translating only a subset of the total content on the site") cited by the Examiner also supports the notion that Lakritz is not directed to translating portion of a document, but instead, to translating entire documents within a site. Appellants, therefore, respectfully submit that Lakritz fails to explicitly disclose "automatically programmatically translating the portion having the first language into said at least one target

language with said 'lang' attribute as a key for machine translation in order to produce a mixed translation of the text," as recited in each of independent claims 1, 4, and 7.

Examiner has not established that the missing limitation is inherently disclosed

Although not specifically argued by the Examiner, Appellants presume that the Examiner may argue that the phrase "only a portion of the documents on the site need be translated" does not exclude the "portion" referring to just a portion of a single document. Since Appellants have established that such a teaching has not been explicitly made by Lakritz, the Examiner can only argue that such a limitation is inherently disclosed by Lakritz. However, such an inherency argument, if asserted by the Examiner, would fail.

Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.¹ To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.² Upon reviewing the Examiner's arguments, Appellants are unable to determine where the Examiner has introduced sufficient evidence to support a finding that this limitation is inherently disclosed by Lakritz. Therefore, Appellants respectfully submit that should the Examiner argue that Lakritz inherently discloses the above-identified missing limitation, this argument would fail.

¹ In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

² In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

For the reasons stated above, the Examiner has failed to establish that Lakritz either explicitly or inherently identically discloses the above-identified limitation within the meaning of 35 U.S.C. § 102. Appellants, therefore, respectfully submit that the Examiner's rejection of claims 1, 3-4, 6-7, and 9 under 35 U.S.C. § 102 for anticipation based upon Lakritz is not factually or legally viable.

**THE REJECTION OF CLAIMS 2, 5, AND 8 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON LAKRITZ IN VIEW OF GREFENSTETTE**

Claims 2, 5, and 8 are patentable at least based upon their dependency respectively to independent claims 1, 4, and 7. As discussed above, the Lakritz fails to explicitly or inherently identically disclose all the limitations recited in independent claims 1, 4 and 7. Furthermore, the Examiner has not established that the Examiner's secondary reference of Grefenstette overcomes the previously argued deficiencies of Lakritz.

**THE REJECTION OF CLAIMS 10-12 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED
UPON LAKRITZ IN VIEW OF GREFENSTETTE**

Claims 10-12 are patentable at least based upon their dependency respectively to independent claims 1, 4, and 7. As discussed above, the Lakritz fails to explicitly or inherently identically disclose all the limitations recited in independent claims 1, 4 and 7.

Conclusion

Based upon the foregoing, Appellants respectfully submit that the Examiner's rejections

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under 35 U.S.C. §§ 102, 103 are not factually or legally viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 102, 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461 and please credit any excess fees to such deposit account.

Date: May 20, 2005

Respectfully submitted,



Steven M. Greenberg
Registration No. 44,725
Christopher & Weisberg, P.A.
200 E. Las Olas Blvd., Suite 2040
Fort Lauderdale, FL 33301
Tel: (954) 828-1488
Facsimile: (954) 828-9122

VIII. CLAIMS APPENDIX

1. A method of determining a target language for automatic programmatic translation of text in a first language, comprising the steps of:
creating text in the first language;
using an HTML 'lang' attribute to set at least one target language for a portion of the text which is different from the first language; and,
automatically programmatically translating the portion having the first language into said at least one target language with said 'lang' attribute as a key for machine translation in order to produce a mixed translation of the text.

2. The method of Claim 1, further comprising the step of:
using Language Guessing to determine the first language.

3. The method of Claim 1, wherein said at least one target language comprises a plurality of languages resulting in translation into a mixed language content.

4. A system for determining a target language for automatic programmatic translation of text in a first language, comprising:
creating text in the first language;
using an HTML 'lang' attribute to set at least one target language for a portion of the text which is different from the first language; and,
automatically programmatically translating the portion having the first language into said at least one target language with said 'lang' attribute as a key for machine translation in order to produce a mixed translation of the text.

5. The system of Claim 4, further comprising:
using Language Guessing to determine the first language.

6. The system of Claim 4, wherein said at least one target language comprises a plurality of languages resulting in translation into a mixed language content.

7. A computer program product recorded on computer readable medium for determining a target language for automatic programmatic translation of text in a first language, comprising:
creating text in the first language;
using an HTML 'lang' attribute to set at least one target language for a portion of the text which is different from the first language; and,
automatically programmatically translating the portion having the first language into said at least one target language with said 'lang' attribute as a key for machine translation in order to produce a mixed translation of the text.

8. The program product of Claim 7, further comprising:
using Language Guessing to determine the first language.

9. The program product of Claim 7, wherein said at least one target language comprises a

plurality of languages resulting in translation into a mixed language content.

10. The method of Claim 1, further comprising the step of:
using a second 'lang' attribute to set an additional target language for another portion of the text which is different from the first language and the language specified by said HTML 'lang' attribute; and,
automatically programmatically translating the another portion having the first language into said additional target language with said second 'lang' attribute as a key for machine translation.

11. The system of Claim 4, further comprising:
using a second 'lang' attribute to set an additional target language for another portion of the text which is different from the first language and the language specified by said HTML 'lang' attribute; and,
automatically programmatically translating the another portion having the first language into said additional target language with said second 'lang' attribute as a key for machine translation.

12. The program product of Claim 7, further comprising:
using a second 'lang' attribute to set an additional target language for another portion of the text which is different from the first language and the language specified by said HTML 'lang' attribute; and,
automatically programmatically translating the another portion having the first language into said additional target language with said second 'lang' attribute as a key for machine translation.